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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) <b>00380363aa</b>									
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<table border="1"> <tr> <td colspan="2">Application Number <b>09/745,730</b></td> <td>Filed <b>12/26/00</b></td> </tr> <tr> <td colspan="3">First Named Inventor <b>Kobayashi</b></td> </tr> <tr> <td colspan="2">Art Unit <b>2616</b></td> <td>Examiner <b>Scheibel</b></td> </tr> </table>			Application Number <b>09/745,730</b>		Filed <b>12/26/00</b>	First Named Inventor <b>Kobayashi</b>			Art Unit <b>2616</b>		Examiner <b>Scheibel</b>
Application Number <b>09/745,730</b>		Filed <b>12/26/00</b>									
First Named Inventor <b>Kobayashi</b>											
Art Unit <b>2616</b>		Examiner <b>Scheibel</b>									
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p>											
<p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>											
<p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <b>32,635</b></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p>											
 <p>Signature <b>Michael E. Whitham</b></p> <p>Typed or printed name</p> <p><b>703-787-9400</b> Telephone number</p> <p><b>9-13-06</b> Date</p>											
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>											

\*Total of **1** forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of

Yoshikazu Kobayashi Confirmation No. 1971

Serial No.: 09/745,730 Group Art Unit: 2616

Filed: December 26, 2000 Examiner: Scheibel, Robert C.

For: Telephone Controller for VoIP

Mail Stop AF  
Commissioner for Patents  
PO Box 1450  
Alexandria, Virginia 22313-1450

**ATTACHMENT TO PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir:

This Pre-Appeal Brief Request for Review is being concurrently filed in the USPTO with a Notice of Appeal. A check is attached to satisfy the fees for a Notice of Appeal. If any additional fees are required to satisfy the fees due for the Notice of Appeal or to gain entry and consideration of this Pre-Appeal Brief Request for Review, the Commissioner is authorized to charge Attorney's Deposit Account 50-2041 (Whitham, Curtis, Christofferson & Cook).

**The Invention**

The invention provides telephone controllers (independent Claims 1, 12); telephone communication systems composed of LAN connected to the Internet, a telephone controller and plural telephone sets that mutually communicate via the LAN (independent Claim 4). Note that thanks to the invention, a telephone comprising an inventive telephone controller (that controls plural telephone sets via LAN connected to the Internet) can be connected by a user having no knowledge of IP and LAN. (See Claims 1, 4.)

Some embodiments of the invention include a receiver that receives a message sent via LAN by one of the telephone sets for requesting an IP address be allocated for the requesting telephone set. (Claims 1, 12; see also Claim 4)

Some embodiments of the invention include "a control circuit that

generates an ID comprising a domain name and an extension of the requesting telephone set in case the message for requesting the IP address is received” (Claims 1, 4, 12).

Some inventive embodiments include “an IP address allocation circuit that allocates the IP address of the requesting telephone set”. (Claims 1, 4, 12.)

Some inventive embodiments include “a table that stores an ID comprising a domain name, an extension and the IP address” (Claims 1, 4, 12).

Some inventive embodiments include “a notifying unit that notifies the requesting telephone set of the ID, the extension and the IP address for the requesting telephone set”. (Claims 1, 4, 12.)

In some inventive embodiments, “one of the telephone sets is provided with a transmitter that transmits via LAN a message for requesting an IP address be allocated for the requesting telephone set to the telephone controller”. (Claim 4.)

### **Errors and Omissions**

#### *The Obviousness Rejection Based on Alexander and Eastep.*

1) Applicant respectfully submits that the Examiner has erred by rejecting Claims 1-12 as unpatentable over Alexander (USP 6,798,767) in view of Eastep (USP 6,731,625). As recited in Applicant’s claim 1, “a telephone comprising said telephone controller can be connected by a user having no knowledge of IP and LAN”. A telephone comprising Alexander’s telephone controller requires a knowledgeable user to make the connection. This distinction between Applicant’s claim 1 and Alexander is substantial and patentably significant.

Moreover, Eastep fails to this additional feature missing from Alexander. Eastep relates to the integration of the Internet with telephony systems. Eastep does not suggest motivation for making a telephone with Alexander’s controller connectible by a LAN/IP unsophisticated user. For instance, Eastep teaches that to adopt MCI’s “ISDN, an end user or company must upgrade to ISDN terminal equipment, central office hardware, and central office software.” To perform the upgrade needed in Eastep clearly requires someone sophisticated, not unsophisticated, to connect telephones. Even with Alexander and Eastep, a person of ordinary skill in the art would not invent a telephone controller that

makes a telephone connectable by a user unsophisticated in LAN/IP. Claims 1 and 4, and the claims depending thereon, are non-obvious over Alexander and Eastep.

There are additional, separate reasons for non-obviousness. Namely, Applicant rebuts several of the Examiner's assumptions set forth in the office action.

2) For example, Alexander only deals with users' IP addresses (see, e.g., Fig. 4B) but fails to teach ID comprising a domain name. The Examiner admits that Alexander fails to expressly disclose that the ID comprises a domain name but incorrectly trivializes this recitation and, to allegedly supply this deficiency in Alexander, the Examiner resorts to Eastep and proposes to modify one of the extensions assigned by Alexander to be an email address. The Examiner's position is that at the time of the invention it would have been obvious to a person of ordinary skill in the art to modify Alexander to assign an extension which is an email address; the Examiner states that the motivation would have been to allow the use of a familiar identifier to uniquely identify the user.

However, contrary to the assumption underlying the Examiner's position, a person of ordinary skill in the art reading Eastep and Alexander would not take away from Eastep that he should try to modify Alexander to use an email address in assigning an extension. Rather, what the person of ordinary skill in the art would see is that Alexander provides a system for generating line appearances at one or more alternate telephony devices with a target telephony device in response to a call made to the target telephony device. (Col. 1, lines 40-45.) In Alexander, the user may associate one or more alternate devices with a target telephony device such that the alternate devices are rung when a call is placed to the target telephony device. (Col. 2, lines 12-15.) It would not make sense to try to introduce email addresses into Alexander—that does not readily fit into Alexander and would only be a complicating factor. The Examiner's theory that using email addresses would somehow improve Alexander because supposedly that would permit unique identification of the user is not technically valid, because Alexander is already accomplishing what he needs to do using unique identifying alternate numbers and IP addresses (Figs. 3, 4B). Rather, if a person of ordinary skill in the art were given Alexander and Eastep and asked for his thoughts, on the points for

which the Examiner has tried to combine them, the references would seem separate to him. Objectively speaking, Eastep would not cause him to focus on use of IP addresses in Alexander. Therefore, the Examiner's assumption that Eastep allegedly provides motivation to modify Alexander to change an extension to an email address has been rebutted. This assumption having been rebutted, the obviousness rejection should be withdrawn.

(3) Another reason requiring a conclusion of non-obviousness is as follows. Applicant's claim 1 recites a table that stores an ID comprising a domain name. Alexander lacks Applicant's inventive table; Alexander's table is missing the ID. Although the Examiner admits that Alexander fails to disclose that the ID, extension and the IP address are all stored in a single table, the Examiner gives insufficient weight to the differences between Alexander and Applicant's claimed invention. The Examiner's assumption is that at the time of Applicant's invention it would have been obvious to a person of ordinary skill in the art to modify Alexander to combine tables 4A and 4B. The Examiner alleges cost reduction as motivation. Applicant rebuts the Examiner's cost-reduction assumption as follows: Alexander is able to accomplish his objective of getting alternate telephony devices to ring by using his table (Fig. 4B) which includes IP address but without including something further such as ID comprising a domain name. Because Alexander can accomplish what he wants to do with his "simple" table (Fig. 4B), adding anything to Alexander's table would only be an unnecessary complicating factor and therefore cannot reasonably be characterized as cost-reducing as the Examiner proposes. Therefore, the assumption that Alexander's simple table would be modified has been rebutted; the obviousness rejection requiring that assumption should be withdrawn.

(4) A telephone comprising the inventive telephone controller is connectible by a user who has no knowledge of IP and LAN. See also Applicant's specification at page 6, lines 10-11, which is evidence under oath and should be considered as if stated in a Declaration Under 37 C.F.R. 132. By contrast, a telephone comprising Alexander's controller would be unconnectible by the same unsophisticated user. "Presence of a property (connectability by a user unsophisticated with IP/LAN) not possessed by the prior art is evidence of nonobviousness." MPEP 716.02(a) *citing In re Papesch*, 315 F.2d 381, 137

USPQ 43 (CCPA 1963).

**Conclusion**

In view of the above alternate, separate reasons, it is requested that the position of the Examiner be reviewed, that the obviousness rejection be withdrawn, and that the application be awarded a notice of allowance.

Respectfully submitted,



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